

REMARKS

United States Patent No. **6,327,578** was filed on December 29, 1998 and issued on December 4, 2001 with claims 1-54. In the reissue application dated July 17, 2003, claims 55-67 were added.

In an Office Action dated April 25, 2006, Examiner Salvatore A. Canglasi rejected claims 1-67 on the grounds of undue multiplicity. Examiner Canglasi indicated that because he "believes in his judgment that twenty (20) claims are sufficient to properly define applicants' [sic] invention, applicants are required to select certain claims, not to exceed twenty for examination on the merits of which no more than six independent claims. . . . [T]he **non-selected claims must be cancelled.**" (emphasis in original)

In a previous amendment dated July 25, 2006, claims 3, 5-14, 19-23, 30-54 and 62-67 were canceled without prejudice as required by an Office Action dated April 25, 2006. This amendment was made solely in order to comply with the aforementioned requirement based on the alleged undue multiplicity of these claims.

In a telephone interview conducted on December 7, 2007, with David E. Shifren (Reg. No. 59,329), Primary Examiner Calvin Loyd Hewitt II withdrew the undue multiplicity rejection as having been improper and invited Applicant to reinstate cancelled claims 3, 5-14 and 19-23.

New dependent claims 68-83 contain limitations similar to those found in cancelled dependent claims 3, 5-14 and 19-23. As such, these claims do not introduce new matter. Moreover, these claims are allowable at least because of their dependency from claim 1.

New claims 84-93 have also been added. Support for these new claims can be found throughout the specification of the patent. New independent claim 84 discloses a method of providing at least a part of a four party payment service, the part of the service being provided in accordance with a gateway associated with an issuing bank, comprising steps similar to those recited in claim 55. New independent claim 88 discloses a method of providing at least a part of a four party payment service, the part of the service being provided in accordance with a computer of a merchant, comprising steps similar to those recited in claim 61. New independent claim 89 discloses a method of operating a four party payment protocol in accordance with a gateway associated with an issuing bank, comprising steps similar to those recited in claim 55.

New independent claim 93 discloses a method of operating a four party payment protocol in accordance with a computer of a merchant, comprising steps similar to those recited in claim 61.

New dependent claims 85-87 and 90-92 contain limitations similar to those found in dependent claims 56-58. As such, these claims do not introduce new matter. Moreover, these claims are allowable at least because of their dependency from their respective independent claims.

Support for new claims 84-93 can initially be found in FIGS. 2B, 2C, and 4. The description of FIG. 2B begins on line 14 of column 6 and ends at line 20 of column 7; the description of FIG. 2C is found in column 7, lines 21-54; and the description of FIG. 4 begins on line 18 of column 14 and ends on line 5 of column 15. Additional support for these claims can also be found in the remaining FIGS. and their descriptions, for example, in FIG. 8 and its description beginning on line 53 of column 8 and continuing to line 28 of column 9. A more detailed description of the protocol steps follows in columns 10-16.

In the outstanding Office Action dated July 19, 2007, the Examiner: (i) objected to the claims for failure to establish authorization to act on behalf of the assignee; (ii) objected to the claims for an incomplete mailing address on the Reissue Application Declaration by the Inventor; (iii) objected to the claims for failure to comply with 37 CFR §1.173(b) with regard to the amendments; and (iv) rejected claims 1, 2, 4, 15-18, 24-29, 55-58 and 61 under 35 U.S.C. §251.

With regard to the objection for failing to establish authorization to act on behalf of the assignee, Applicant respectfully contends that the original "Reissue Application: Consent of Assignee; Statement of Non-Assignment," signed by IBM IP Staff Attorney, David M. Shofi, sufficiently established authorization to act on behalf of the assignee IBM. Further, Applicant respectfully asserts that the additional "Revocation of Power of Attorney with New Power of Attorney and Change of Correspondence Address" and accompanying statement under 37 CFR 3.73(b) signed by Lynne D. Anderson and dated April 7, 2006, sufficiently completes the chain of authorization to act on behalf of the assignee IBM. Notwithstanding this traversal, Applicant is submitting herewith a new "Reissue Application: Consent of Assignee; Statement of Non-Assignment" (PTO/SB/53) and accompanying statement under 37 CFR 3.73(b), both signed by

Lynne D. Anderson, solely in order to expedite the reissue process by conforming to the subjective preferences expressed in the present Office Action.

With regard to the objection for an incomplete mailing address on the “Reissue Application Declaration by the Inventor,” Applicant respectfully contends that it is common practice to put the town, state, and ZIP code in the residence portion of an address field and to put the street number and street address in the mailing address and, moreover, that it is unlikely that anyone would misinterpret the residence and mailing address as written. Notwithstanding this traversal, Applicant is submitting herewith a new Reissue Application Declaration for the above-identified reissue application, solely in order to expedite the reissue process by conforming to the subjective preferences expressed in the present Office Action.

With regard to the objection that the amendments fail to comply with 37 CFR §1.173(b), Applicant respectfully submits that §1.173(b), which states that “an amendment in a reissue application is made either by physically incorporating the changes into the specification when the application is filed or by a separate amendment paper,” does not require that all amendments be combined into one amendment. Moreover, Applicant respectfully note that 37 CFR §1.173(b)(2) recites that, “[f]or any claim changed by the amendment paper, a parenthetical expression ‘amended,’ ‘twice amended,’ etc., should follow the claim number,” which clearly indicates that multiple amendments may occur during the reissue process.

Notwithstanding the above traversal, Applicant is submitting herewith a single amendment compiling all amendments relative to the issued patent since the filing of the reissue, pursuant to 37 CFR §1.173(g). See Responses to Office Actions dated January 31, 2006, July 25, 2006, December 8, 2006, March 26, 2007, and April 9, 2007. The amendments also include the Examiner’s amendment dated May 22, 2007. However, Applicant submits these amendments solely to expedite the reissue process by conforming to the subject preferences expressed in the present Office Action.

With respect to the rejection of claims 1, 2, 4, 15-18, 24-29, 55-58, and 61 under 35 U.S.C. §251, Applicant is submitting herewith a “Supplemental Declaration for Reissue” signed by the inventor that declares that any amendment since the time of filing the reissue arose without any deceptive intention on the part of the Applicant.

Moreover, Applicant respectfully submits that original Reissue Application Declaration filed on July 17, 2003 amended claim 50 and, therefore, the original oath was a correct statement of fact at the time of filing. Moreover, the original Reissue Application Declaration identified at least one error which is relied upon to support the reissue.

Notwithstanding the above traversal, Applicant is submitting herewith a new Reissue Application Declaration identifying new claim 61 as being broader in scope than the original claim set. Specifically, claim 61 recites a limitation wherein a merchant message comprises a “merchant identifier,” while the original claims contained a limitation wherein a merchant message comprises a “merchant digital signature.” Applicant respectfully submits that a “merchant identifier” is of a broader scope than the “merchant digital signature” recited in the original claims. Because the scope of claim 61 encompasses embodiments wherein a merchant message comprises a merchant identifier other than a merchant digital signature, which were outside of the originally issued claims, Applicant respectfully submits that this is a proper broadening reissue. See, e.g., MPEP 1412.03 (emphasis in original):

A claim of a reissue application enlarges the scope of the claims of the patent if it is broader in *at least one* respect, even though it may be narrower in other respects.

A claim in the reissue which includes subject matter not covered by the patent claims enlarges the scope of the patent claims. For example, if any amended or newly added claim in the reissue contains within its scope any conceivable product or process which would not have infringed the patent, then that reissue claim would be broader than the patent claims.

Applicant also asserts that claim 61 may comprise other broadening aspects.

In view of the traversals above and the documents submitted herewith, Applicant believes that claims 1, 2, 4, 15-18, 24-29, 55-58, 61 and 68-93 are in condition for allowance, and respectfully requests withdrawal of all pending rejections and objections.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "David E. Shifren". The signature is fluid and cursive, with the first name "David" and last name "Shifren" clearly distinguishable.

Date: December 17, 2007

David E. Shifren
Attorney for Applicant(s)
Reg. No. 59,329
Ryan, Mason & Lewis, LLP
90 Forest Avenue
Locust Valley, NY 11560
(516) 759-2641